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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/535,378  | 06/29/2006  | Mark H Kaplan        | 50425/223           | 1608             |
| 1912 7590 10/30/2008<br>AMSTER, ROTHSTEIN & EBENSTEIN LLP<br>90 PARK AVENUE<br>NEW YORK, NY 10016 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| CHUNDURU, SURYAPRABHA   |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
| 1637  |             |                      |                     |                  |
| MAIL DATE   |             | DELIVERY MODE        |                     |                  |
| 10/30/2008  |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/535,378

**Applicant(s)**

KAPLAN, MARK H

**Examiner**

Suryaprabha Chunduru

**Art Unit**

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-2, 13, 16, 19-20, 22, 24-27, 34-35, 41, 72, 119-123 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 13, 16, 19, 20, 22, 24-27, 34, 35, 41, 72 and 119-123 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 19 May 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-846)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 05, 2008 has been entered.

***Status of the application***

2. Currently claims 1, 2, 13, 16, 19-20, 22, 24-27, 34-35, 41, 72, 119-123 are pending. Applicants' arguments and the amendment have been fully considered and deemed persuasive in-part for the reasons that follow. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to arguments:***

3. With regard to the rejection of claims 1-2, 13, 16, 19-20, 34-35, 72, 119-123 under 35 USC 102(b) as being anticipated by Chang et al., Applicants' arguments and amendment were fully considered and found persuasive in-part. The amendment did not overcome the rejection since the limitations in the instant claims as amended read on the sequences as disclosed by Chang et al., because the sequence taught by Chang et al. comprises at least one intron of ELF3 gene, wherein said gene consists of SEQ ID NO. 10 as discussed in the rejection. The claims as presented are in open 'comprising' language and requires 'at least one intron' clearly reads on Chang et al. sequence that comprises at least one intron consisting of SEQ ID No. 10 and additional sequences of SEQ ID No. 11, 13, 15. Further the cDNA nucleotide sequence as disclosed by Chang et al. comprises 100% complementarity to the claimed SEQ ID NO. 10 and

fully complementary sequences to SEQ ID Nos. 11, 13, 15, thus the claims as recited are anticipated by the disclosure of Chang et al. and therefore the rejection is maintained.

4. With regard to the rejection of claim 41, under 35 USC 103(a) as being obvious over Chang et al. in view of Lowe et al. Applicants' arguments and the amendment have been fully considered and found unpersuasive. As discussed above the amendment did not overcome the rejection under 35 USC 102(b) and it would be obvious to modify the teaching of Chang et al. in view of Lowe et al. to generate PCR primers or primer pairs from known sequences. The rejection is maintained.

5. With regard to the rejection of claims 1-2, 13, 16, 19-20, 24-27, 34-35, 41, 72, 119-123 under 35 USC 112, first paragraph (written description), Applicants' arguments and amendment are fully considered and found persuasive in-part. The rejection of the instant claims 1-2, 16, 20, 24, 34-35 is withdrawn herein in view of the amendment. However the claims 13, 19, 22, recite 'a portion of' and claims 24-27, 41, 72, 119-123 read on fragments including by permutations and combinations deletions, substitutions or insertions, for which the instant specification lacks support. Therefore the rejection is maintained for claims 13, 19, 22, 24-27, 41, 72, 119-123.

### ***Conclusion***

No claims are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 571-272-0783. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 571-272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Suryaprabha Chunduru/

Primary Examiner, Art Unit 1637